REMARKS

Claims 1-7, 9-17, 19, 21 and 22 are pending in the current application. Claims 1-7, 9-17, 19, 21, and 22 are rejected under 35 U.S.C. §103. This application is amended by the virtue of this response, pursuant to 37 CFR 1.116. Please amend claims 5. Please cancel claims 1-4 and 17-22. No new matter is added. Support for the amended or the new claims is provided within the specification and the claims as filed.

Applicant is not conceding that the subject matter recited in the amended or canceled claims prior to this Amendment is not patentable over the art cited by the Examiner. The amended or cancelled claims in this Amendment are provided solely to facilitate expeditious prosecution of the allowable subject matter noted by the Examiner. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or cancelled claims and additional claims in one or more continuing applications.

Interview Summary:

A telephonic Examiner Interview was conducted with the Examiner upon receiving the pending Office Action to discuss proposed amendments to the claimed subject matter as recited in the claims. The Examiner suggested that providing a more definitive recitation of the following elements may be sufficient to overcome the §103 rejections in view of the cited references: (1) type of data stored in the claimed priority database and (2) how the data stored in the priority database is used to reduce collision and improve access bandwidth when a plurality of end users attempt to access different devices in the local area network.

Claim of Priority

Applicant thanks the Examiner for acknowledgement of the Applicant's claim of foreign priority under 35 U.S.C. § 119(a). However, we note none of the boxes were marked on the Office Summary page. Please let us know if all, some or none of the copies have been received.

§103 Rejection(s):

Claims 1-4, 17, 19, 21 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0180579 to Nagakoa et al. (hereinafter

"Nagakoa") in view of U.S. Patent No. 6,058,426 to Godwin, et al. (hereinafter "Godwin"). The above-noted claims have been cancelled and thus the pending rejection as to these claims is now rendered moot.

Claims 5-7, and 9-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nagakoa in view of U.S. Patent No. 5,758,057 to Baba, et al. (hereinafter "Baba"). This rejection is respectfully traversed.

It has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,[1] to establish a prima facie case of obviousness, the Examiner must <u>clearly articulate</u> the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include: Combining prior art elements according to known methods to yield predictable results, simple substitution of one known element for another to obtain predictable results, use of known technique to improve similar devices (methods, or products) in the same way, etc.

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[1] *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007).

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Neither Nagakoa nor Baba teach or suggest all the recited elements in the pending claims, either alone or in combination. Particularly, neither of the cited references teach or suggest "a remote control system of a home network, the remote control system comprising:

1) a device control processing unit in communication with one or more devices connected to a local area network;

2) a remote terminal service unit in communication with one or more remote terminals connected to a wide area network,

   a. wherein the remote terminals communicate with the remote terminal service unit over the wide area network to control the operation of the one or more devices connected to the local area network;

3) a remote access service unit in communication with the device control processing unit and the remote terminal service unit, wherein the remote access service unit is configured for:

   a. receiving a web request from a remote terminal service unit, wherein the web request is submitted to the remote terminal service unit from the one or more terminals connected to the wide area network;

   b. converting the web request to a service request according to the content of the web request and transmitting the web request to the device control processing unit, wherein the service request is serviced by the device control processing unit by way of submission of the service request to one or more devices connected to the local area network;

   c. receiving a response to the web request from the one or more devices connected to the local network by way of the device control processing unit; and

   d. transmitting a web response for a pertinent remote terminal to the remote terminal service unit by having a service view comprising at least one web document,

4) wherein the remote access service unit includes a profile database comprising:

   a. a list of priorities associated with the devices connected to the local area network; a list of priorities for requested events;

b. attributes of the one or more remote terminals including a screen size and a type of an input device;

c. a network provider's network bandwidth and services available from the provider; and access priority assigned to each remote terminal,

5) wherein the remote access service unit includes a mechanism for reducing burden on the device control processing unit, in response to determining that multiple remote terminals simultaneously submit requests to the remote terminal service unit,

6) such that a collision between submitted service requests is solved according to at least one of priority associated with each requested operation or a priority of access assigned to each remote terminal,

7) wherein information regarding the priority of each operation and the priority of access assigned to each terminal is stored in the profile database accessible by the remote access service unit,

8) such that requests received for performing operations with higher priority are performed first and requests received from terminals with a higher access priority are serviced first when a collision is detected."

Respectfully, the Examiner other than picking and choosing different elements and limitations from among a plurality of somewhat unrelated references has not been able to meet any of the above requirements or articulate any reason with a reasonable degree of clarity to indicate why such references can be combined in the manner suggested by the Examiner.

The question of whether a cited reference can properly be modified in a §103 rejection is not whether a particular limitation was known at time of invention, but rather whether there is a reason that would make it obvious for one of ordinary skill in the art at the time of the invention to modify the cited reference to include that particular limitation. As the U.S. Supreme Court has affirmed, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1397 (2007).

Additionally, it is improper to use Applicant's disclosure as a road map for selecting and combining prior art references. See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Applicant respectfully submits that in the absence of any legitimate reason that it would be obvious to combine the cited references, the Office Action has used Applicants' claims as a road map for modifying the cited reference.

Nagakoa is directed to a system with a remote access service unit that includes a database as provided in FIG. 6 and paragraphs 0051, 0186 and 0195. The Examiner contends that Nagakoa discloses the use of a profile database for the remote access service unit because Nagakoa discloses customer management database used to show a user ID associated with a home network, remote terminal, and security level, in FIG. 6 and at paragraph 0051. Applicant's review of the cited portions reveals the system of Nagakoa teaches presetting program recording in a video recorder (paragraph 0186) and control completion information for showing that the control designated by control instruction CI1 is performed (paragraph 0195). It appears that the "control completion information" disclosed in Nagakoa was interpreted by the Examiner to be analogous to the profile database recited in independent claim 5. However, it is respectfully submitted that Nagakoa fails to teach or suggest the profile database as recited in amended claim 5.

FIG. 6 and paragraph 0051 of Nagakoa disclose that memory of customer management database provides a terminal ID, a home network ID for home network which a use can control, and a security level corresponding to the user of customer management database and the customer management database corresponds to a user ID belonging to the user of terminal. (see paragraph 0118). The customer management database disclosed in Nagakoa merely includes a user ID, terminal ID, home network ID, and security level as shown in FIG. 6. The Examiner contends that Nagakoa discloses a list of devices preferred by the user (in FIGS. 6 and 14A-14N, and paragraphs 0126 and 0182), a list of requested events (at paragraph 0195), performance of the remote access terminal including a screen size and a type of an input device (in FIG. 8 and paragraphs 0133 and 0135), and network provider's network bandwidth and services available from the provider (in FIGS. 3, 6, 14A-14N, and 15A-15L). Respectfully, not all of the above-referenced elements are included in the customer management database of Nagakoa. The

Examiner is requested to point out each and every one of said elements with more specificity or otherwise withdraw the 103 rejection.

Further, Nagakoa discloses that the profile database includes a list of devices preferred by the user because Nagakoa discloses that the user can set his security setting to configure what devices are displayed on the user terminal to show only the devices the users prefer, citing FIGS. 6 and 14A-14N, and paragraph 182. According to FIG. 6 and paragraphs 0120-0128 of Nagakoa, the security level shows the limit range with regard to the control when each user performs the remote control for home network, the security level showing the ranges of beginning and ending which enables the user to control. Even further, according to Nagakoa, level 1 is the lightest level and a user of a terminal whose level 1 is set can perform remote control of security system provided in home network, and every home-located electronic device in home-located electronic device group while a user of a terminal whose level 3 is set cannot perform the remote control of the system security, and some specified items with regard to home-located electronic device group.

According to Nagakoa, the security level is set purely for securing the home network from remote access, but not to set a list of preferred devices by the user, as recited in independent claim 5. For example, as disclosed at paragraph 0127 of Nagakoa, "security level 3 is preset to a disable status for control of water heater in home-located electronic device group 62, to thereby prevent a child controlling the temperature, or unlocking a door by mistake." Therefore, it is respectfully submitted that Nagakoa fails to disclose or suggest, at least a profile database comprising a list of devices preferred by the user, as recited in independent claim 5.

Further, Nagakoa fails to disclose or suggest a profile data base comprising a list of devices preferred by the user, a list of requested events, performance of the remote terminal including a screen size and a type of an input device, network provider's network bandwidth and services available from the provider, and user access priority for each device, as recited in independent claim 5.

Moreover, Nagakoa discloses that the database includes screen size of the remote access terminal citing FIGS. 6 and 8, and paragraphs 0133 and 0135. The Examiner contends that the cited portions of Nagakoa disclose that the data is generated and transmitted to the terminal based on the size of the picture that can be displayed on the remote terminal. It is respectfully submitted that the asserted size of the picture disclosed in Nagakoa is not the same as the screen size of the remote terminal recited in independent claim 5.

It is noted that the cited portions of Nagakoa disclose a conceptual diagram showing memory of customer management database (FIG. 6 and paragraph 0118) and a conceptual diagram illustrating memory of terminal information database (FIG. 8 and paragraph 0133). It is further noted that the cited paragraphs 0133 and 0135 of Nagakoa discloses that the system control unit modifies data which should be transmitted to the terminal depending upon the communication capability and the display capability, which is provided in the terminal information database.

Even though the Examiner asserts that the customer management database disclosed in Nagakoa is analogous to the profile database recited in independent claim 5 as discussed above, the examiner claims that the display capability provided in the terminal information database is an element of the asserted profile database. However, it is respectfully submitted that the customer management database disclosed in FIG. 6 of Nagakoa and the terminal information database disclosed in FIG. 8 are not the same. (see also FIG. 5). It is further respectfully submitted that Nagakoa fails to disclose or suggest a profile database comprising, at least, performance of the remote terminal including a screen size and a type of an input device, as recited in independent claim 5.

Baba is directed to a multi-media storage system having a plurality of disk drives. In particular, it is respectfully noted that the cited portion of Baba discloses avoiding waiting for access to the storage when a plurality of users access the storage by predetermining a priority of the users to access a specific disk drive. Therefore, it is respectfully submitted that Baba merely discloses accessing a multi-media storage system and as such fails to cure the above-identified deficiencies of Nagakoa with regard to independent claim 5. Accordingly, it is respectfully

submitted that independent claim 5 is distinguishable over Nagakoa and Baba. It is further respectfully asserted that claims 6, 7, and 9-16, which depend from independent claim 5, are allowable, at least, by virtue of their dependencies upon patentable base claim 5.

It is respectfully noted that §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

Respectfully neither of the cited references either alone or in combination teach or suggest the above enumerated recited elements. And, while the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.,* 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,[2] or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.[3]

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn. For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in the claims. Therefore, it is respectfully submitted that the claims are in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 or e-mail at ffar-hadian@lhlaw.com to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: April 20, 2009   By: /F. Jason Far-hadian/
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[2] *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

[3] "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

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